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10/765,433	01/27/2004	Werner Franz Reichert	LWEP:123 US	1514
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Howard M. Ellis SIMPSON & SIMPSON, PLLC 5555 Main Street Williamsville, NY 14221			AMARI, ALESSANDRO V	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/765,433	<b>Applicant(s)</b> REICHERT ET AL.	
	<b>Examiner</b> Alessandro V. Amari	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-11 and 22 is/are allowed.
- 6) ☒ Claim(s) 1-8, 12-21 and 27-31 is/are rejected.
- 7) ☒ Claim(s) 18 and 23-26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 17, 19-21 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitzkus et al US 6,717,724 in view of McGrath et al US 5,810,301.

In regard to claim 17, Mitzkus et al teaches (see Figures 1-4) a microscope carrier comprises a microscope carrier body (2, 6), a left and a right hand rest (1) attached to the body as described in column 2, lines 54-67.

However, in regard to claim 17, Mitzkus et al does not teach that the left and right hand rests pivot freely and independently of one another.

In regard to claim 17, McGrath et al teaches (see Figures 1-3) that left and right hand rests (34) pivot freely and independently of one another (see pivot point on axis 54) as described in column 9, lines 10-18.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the handrests of Mitzkus et al pivot freely and independently as taught by McGrath et al in order to provide individual adjustability for the user so as to improve the ergonomics of the microscope carrier.

Regarding claim 19, Mitzkus et al teaches (see Figures 1-3) that the left and the right hand rest are adapted for hooking (via element 8) onto a left and a right lateral cheekpiece of the body (left and right sides of the body 2 which face the handrests 1).

Regarding claim 20, Mitzkus et al teaches (see Figure 1) that the hand rests each comprise a front edge (3); and the hand rests taper from a certain segment toward the front edge as shown in Figure 1.

Regarding claim 21, Mitzkus et al teaches (see Figures 1, 2) that the microscope carrier is equipped with a plurality of pivotable supports (4, 5) that make available at least a three-point support (see distal end of element 6) of the microscope carrier on a bench surface as shown in Figures 1 and 2 and as described in column 3, lines 1-15.

Regarding claim 31, Mitzkus et al teaches (see Figure 1) at least one opening (7) for attaching the microscope is provided in the microscope carrier as described in column 2, lines 63-64.

3. Claims 1-8, 12-16 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitzkus et al US 6,717,724 in view of McGrath et al US 5,810,301 and further in view of Kline et al US 5,195,705.

In regard to claims 1 and 12, Mitzkus et al teaches (see Figures 1-4) an ergonomic microscope comprising a microscope carrier comprising a carrier body (2, 6), a left and a right hand rest (1) with each rest defining a front edge (3), attached to the carrier body wherein the left and right hand rests pivot (with respect to elements 4, 5) so that regardless of the adjustment their front edges rest on a bench surface as described in column 2, lines 54-67 and column 3, lines 1-15.

However, in regard to claims 1 and 12, Mitzkus does not teach that the left and right hand rests pivot freely and independently of one another.

In regard to claims 1 and 12, McGrath et al teaches (see Figures 1-3) that left and right hand rests (34) pivot freely and independently of one another (see pivot point on axis 54) as described in column 9, lines 10-18.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the handrests of Mitzkus et al pivot freely and independently as taught by McGrath et al in order to provide individual adjustability for the user so as to improve the ergonomics of the microscope carrier.

Regarding claims 1, 12 and 27-30, Mitzkus et al in view of McGrath teaches the invention as set forth above, however, in regard to claims 1, 12 and 27, Mitzkus in view of McGrath et al does not teach a stand which has a stand base corresponding to an external contour of the body.

In regard to claims 1, 12 and 27, Kline et al teaches (see Figures 1, 4) a stand base (20) that defines an external contour as shown in Figures 1 and 4. Regarding claims 2 and 13, Kline et al teaches (see Figures 2, 4) that the body or stand base possesses an external contour that corresponds substantially to the external contour of the stand base as shown in Figure 2.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the stand base with the external contour as taught by Kline et al in the microscope carrier of Mitzkus et al in view of McGrath et al in order to provide more stability and rigidity for the microscope carrier.

Regarding claims 3 and 28, Mitzkus et al teaches that the body comprises a housing open toward the bottom as shown in Figures 2 and 3.

Regarding claims 4 and 29, Mitzkus et al teaches (see Figure 1) that the housing of said carrier body comprises a surface in which is embodied at least one depression (7) embedded therein for receiving at least one corresponding foot on the stand base of the microscope as described in column 2, lines 63-64.

Regarding claims 5, 15 and 30, Mitzkus et al teaches (see Figure 1) that the depressions are configured as cutouts or holes, for orienting the microscope on the microscope carrier as described in column 2, lines 63-64.

Regarding claim 6, Mitzkus et al teaches (see Figure 1) a cutout for ventilation or supply is provided on the carrier body (see rectangular hole in element 2).

Regarding claim 7, Mitzkus et al teaches (see Figure 1) at least one opening (7) for attaching the microscope is provided in the body of the microscope carrier as described in column 2, lines 63-64.

Regarding claims 8 and 16, Mitzkus et al teaches (see Figures 1, 2) that the microscope carrier is equipped with a plurality of pivotable supports (4, 5) that make available at least a three-point support (see distal end of element 6) of the microscope carrier on a bench surface as shown in Figures 1 and 2 and as described in column 3, lines 1-15.

Regarding claim 14, Mitzkus et al teaches (see Figures 1, 2, 3) the microscope carrier body comprises a housing open toward the bottom as shown in Figures 2 and 3, and the housing defines a surface in which is embodied at least one depression (7) that

serves to receive at least one corresponding foot on the stand base of the microscope as described in column 2, lines 63-64.

***Allowable Subject Matter***

4. Claims 9-11 are allowed.
5. Claims 18 and 23-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 18 is allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest, "microscope carrier body comprises a left and a right lateral cheekpiece and a hinge system, the left and the right hand rest are attached by means of said hinge system" as set forth in the claimed combination.

The prior art of record teaches a microscope carrier body with a left and right hand rest attached to the body so as to pivot freely and independently of one another but does not teach that the left and right hand rests are attached by means of a hinge system and there is no motivation or teaching to modify this difference as derived.

Claims 9-11 and 23-26 are allowable for the reasons provide in the previous office action.

***Response to Arguments***

7. Applicant's arguments filed 13 October 2005 have been fully considered but they are not persuasive.

The applicant argues that the hand rests as taught by Mitzkus are stationary and non-moveable and thus cannot pivot freely and independently of one another. Further,

the applicant asserts that while the secondary reference McGrath does teach left and right arm rests which can pivot independently of one another, it cannot be combined with Mitzkus because Mitzkus discloses features which prevent movement of their hand rests and combining with McGrath would require removal of these features which would destroy the Mitzkus reference.

In response to this argument, the Examiner disagrees that the hand rests of Mitzkus are stationary and non-moveable. Close examination of Figures 2 and 3 and the associated text (see column 3, lines 1-22) indicates that the hand rests do move relative to the adjustable feet **4, 5**. This is particularly indicated in column 3, lines 4-10 reproduced below:

The adjustable foot 4 is shaped essentially as a right parallelepiped. It is connected to the base plate 1 by the swivel pin 9 which is arranged at different distances from the respective side surfaces (10, 11, 12). Accordingly, the base plate 1 has different inclinations depending on the side surface of the right parallelepiped that is selected for support on the table.

Therefore, since the base plate (i.e., hand rest) can have different inclinations, it must be moveable and thus reads on the limitation that the hand rests can pivot freely as recited in the claims.

The applicant further argues that McGrath discloses that the arm rests **34** are apparently freely moveable along a lateral path and it is not apparent how the stationary arm rests of Mitzkus may be made laterally pivotal. Further, in the same vein, the applicant argues that the Examiner cannot pick and choose elements from the prior art and exclude those that may not be needed. The applicant cites the example that the device of McGrath employs a counter balance member to prevent the assembly from



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tipping and that this feature is not mentioned in the rejection and is therefore evidence of prohibited hindsight reconstruction.

In response to this argument, the Examiner would like to point out that McGrath, the secondary reference is relied upon to furnish the obvious feature of having the hand rests being pivotable freely and independently of one another which is not taught by the primary reference, Mitzkus. One of the tests for obviousness is whether a proposed modification renders the prior art unsatisfactory for its intended purpose. The Examiner has already established that the hand rests are moveable (see above) so adding the teaching of having the rests be pivotable freely and independently as taught by McGrath adds additional ergonomic benefit and in no way destroys or renders the prior art, Mitzkus unsuitable for its intended purpose. The Examiner fails to understand the applicants arguments in regard to "picking and choosing" features (i.e., the rests being laterally pivotal or the incorporation of a counter balance member) since these features are germane to McGrath which is not the reference being modified. The applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) Applicant is also reminded it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

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within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The applicant then argues that there is no teaching or suggestion in the prior art, to support the combination of Mitzkus in view of McGrath.

In response to this argument, the applicant is reminded that the rationale may be in a reference or can be reasoned from common knowledge in the art. In the office rejection, McGrath, at the very least, teaches a structure that more properly supports a user's body (see column 3, lines 27-37 of McGrath) since it provides a feature (i.e., free and independent pivoting) which can be utilized in other support structures such as the microscope carrier of Mitzkus in order to further improve the ergonomics of said structures.

The applicant further argues that Mitzkus achieves their ergonomic support by means of rotating adjustable feet in the rear area of the hand rest/base plate and that the height of the plate is adjusted at the front by a catch mechanism. Hence, the applicant concludes that Mitzkus provides no plausible basis for incorporating the pivoting arm rests of McGrath into the microscope support of the primary reference.

In response to this argument, the applicant's attention is directed to the response above in regard to bodily incorporation of features. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)

The applicant further argues in regard to claim 19, that Mitzkus does not teach that the left and right hand rests can be hooked via element 8 onto the left and right lateral cheekpiece of the body and cites column 3, lines 3-4 of Mitzkus as evidence for this.

In response to this argument, the Examiner would like to point out that as shown in Figures 1 and 2, element 8 is a pin which hooks the left and right hand rests onto the left and right lateral cheekpiece of the body.

The applicant further argues that in regard to claim 20, Mitzkus does not teach a tapered hand rest toward the front edge.

In response to this argument, the Examiner would like to point out that Figure 1 clearly shows a hand rest which tapers toward the front edge. In fact, in column 2, lines 55-56, of the reference teaches that the hand rest 1 has a rounded (i.e., tapered) edge 3 in the front area.

The applicant then argues that the inappropriate conversion of the microscope support of Mitzkus in view of McGrath from one having stationary, non-pivoting hand rests by removing fundamental bridging components would destroy the Mitzkus reference.

In response to this argument, the Examiner wishes to cite the previous discussion above in regard to bodily incorporation and impermissible hindsight.

The applicant further argues that Kline et al does not expressly teach that the contour of the microscope carrier body has the same contour or dimensions of the microscope stand base and that the drawings by themselves cannot be relied on as

enabling teaching of the contour or dimensions of the microscope as necessarily coinciding with those of the top plate.

In response to this argument, the Examiner would like to point out that firstly, claim 1 only recites that the stand base has an external contour and secondly, the drawings alone can be relied upon to provide proportions since the description of the article pictured can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977) Kline teaches that the top plate 22 supports a microscope (see column 2, lines 23-30) and the drawings (see Figure 1), while not explicitly indicated as drawn to scale, clearly shows that the carrier body has the same contour or dimensions that correspond substantially to the external contour of a stand base of the microscope as would be evident to one of ordinary skill in the art. Also, claims 13 and 27 recite that “the external contour of the stand base corresponds **substantially** to the external contour of the microscope carrier body”. Applicant should note the use of the word “substantially” allows the Examiner to broadly interpret Figure 1 of Kline as reading on the claims as currently recited. Therefore, the Examiner maintains that Kline does indeed teach that the contour of the microscope carrier body has the same contour or dimensions of the microscope stand base and the rejection is sustained.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alessandro V. Amari whose telephone number is (571) 272-2306. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PRIMARY EXAMINER